

## **REMARKS**

### **Interview Summary**

Applicant wishes to thank the Examiner for considering the issues raised in the October 24 Office Action during the interview on February 22. During the interview, the Examiner and Applicants' attorney discussed the cited prior art and claim amendments that would put the application in a condition for allowance. The claim amendments discussed in the interview are reflected above. The remainder of the substance of the interview is further reflected below. Applicants believe the application is now in a condition for allowance and appreciates the Examiner's due consideration of the amendments above and the following comments.

### **Claim Rejections**

The Examiner has rejected claims 1-2, 4, 7-9, 12, 17-18, 21-29, 32-34, 37, 42-43 and 47 as being anticipated under 35 U.S.C. § 102(b) by Camrud et al. (U.S. Patent No. 6,258,117). The Examiner has also rejected claims 1, 20, 27 and 45-46 as being anticipated under 35 U.S.C. § 102(e) by Camrud et al. (U.S. Patent No. 6,485,510). The Examiner has also rejected claims 19-44 as being unpatentable under 35 U.S.C. § 103(a) over Camrud '117 in view of Hong et al. (U.S. Patent No. 6,565,599). The Examiner has also rejected claim 3 as being unpatentable under 35 U.S.C. § 103(a) over Camrud '117 in view of Evans et al. (U.S. Patent No. 6,102,938). The Examiner has also rejected claims 13, 16, 38 and 41 as being unpatentable under 35 U.S.C. § 103(a) over Camrud '117 in view of Wu et al. (U.S. Patent No. 6,254,632). The Examiner has also rejected claims 5, 10, 30 and 35 as being unpatentable under 35 U.S.C. § 103(a) over Camrud '117 in view of Kocur (U.S. Patent No. 6,350,277). The Examiner has also rejected claims 14 and 39 as being unpatentable under 35 U.S.C. § 103(a) over Camrud '117 in view of Wu and in further view of Kocur. The Examiner has also rejected claims 6, 11, 31 and 36 as being unpatentable under 35 U.S.C. § 103(a) over Camrud '117 in view of Sirhan et al. (U.S. Patent No. 7,077,859). The Examiner has also rejected claims 15 and 40 as being unpatentable under 35 U.S.C. § 103(a) over Camrud '117 in view of Wu and in further view of Sirhan.

Applicants have carefully considered the Examiner's comments. In response, Applicants have amended claim 27 to incorporate the limitation of cancelled claim 30. Applicants have also added new claims 48-50. Applicants respectfully submit that the prior art of record does not disclose all of the limitations of Applicants' claims as now presented. Moreover, there is no suggestion or motivation to combine the prior art to achieve Applicants' claimed inventions.

Referring to claims 1-26, the Examiner argues that Camrud '117 and Camrud '510 both independently disclose all of the limitations of independent claim 1. However, Applicants respectfully submit that neither of the Camrud references disclose serpentine ring structures extending around the circumference of the stent and having a plurality of strut members and a plurality of bends that form a substantially zig-zag pattern. With respect to both of the Camrud references, the Examiner has stated that stent sections 12, 14, 16, 18 are serpentine ring structures and that Figure 7A of the Camrud references shows a zig-zag pattern. However, neither stent sections 12, 14, 16, 18 nor Figure 7A disclose Applicants' claimed invention. As clearly shown in Figure 1A of the Camrud references, stent sections 12, 14, 16 and 18 are solid rings with no struts, bends or a zig-zag pattern. (Col. 4, lines 51-57). Thus, stent sections 12, 14, 16, 18 cannot disclose Applicants' invention as claimed in claim 1, which requires serpentine ring structures with a zig-zag pattern. Likewise, Figure 7A of the Camrud references does not disclose the limitations of the claimed invention in claim 1. The biodegradable connector that the Examiner relies upon in Figure 7A is material 113. However, material 113 is filled into the overlap regions 110, 112 to fortify the interconnection between the stent sections and the interlocking links 108. (Col. 10, lines 13-16). As clearly shown in Figure 7B, the stent sections and interlocking links 108 remain connected after the material 113 degrades. (Col. 10, lines 13-18). Thus, Figure 7A does not disclose the limitation of claim 1 that the two ring structures must become substantially disjoined after the connector member biodegrades. Accordingly, neither of the Camrud references disclose all of the limitations of claim 1. Therefore, claim 1 is allowable. In addition to these missing limitations, the prior art of record fails to disclose the additional limitations of dependent claims 2-26. Because each of these claims incorporate all of the limitations of allowable claim 1, claims 2-26 are also allowable.

Therefore, any further arguments that could be made at this time in support of the additional limitations of Applicants' dependent claims would be superfluous and unnecessary. *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555 (Fed. Cir. 1983).

Turning to claims 27-47, Applicants have amended independent claim 27 to incorporate the limitation of cancelled claim 30 to more clearly distinguish the claimed invention from the prior art. The Examiner has argued that it would have been obvious to combine Camrud '117 and Kocur to achieve the invention of cancelled claim 30 (now claim 27). However, there is no suggestion or motivation to combine Camrud '117 and Kocur as the Examiner has done. In Kocur, the biodegradable members that the Examiner relies upon are retaining segments. (Col. 8, line 2). Kocur explains that the retaining segments maintain the stent framework in a less than fully expanded configuration until the retaining segments fail. (Col. 3, lines 24-26). As described in the background section of Kocur, the purpose of the retaining segments is to provide a stent that provides some of the characteristics of a balloon expandable stent and some of the properties of a self-expanding stent after the retaining segments fail. (Col. 1, lines 41-52). Therefore, the principle of operation of Kocur is completely different than the claimed invention. MPEP 2143.01 (VI. The Proposed Modification Cannot Change the Principle of Operation of a Reference). In the claimed invention, the biodegradable connector degrades within thirty to one-hundred days after the stent is expanded "so that said two ring structures become substantially disjoined." The purpose of the biodegradable retaining segments in Kocur is completely different. In Kocur the retaining segments are used to restrain expansion of the stent. In the claimed invention, the biodegradable connectors have no effect on the expansion of the stent. In the claimed invention, the biodegradable connectors are used to disjoin separate ring structures over time. However, in Kocur the stent is a unitary structure that is not intended to be disjoined into separate structures. Thus, the retaining segments of Kocur are completely unrelated to the claimed connector member. At best, Kocur suggests that it might have been obvious to try Kocur's retaining segments in the stent structures disclosed in Camrud '117. However, the Federal Circuit has made clear that an "obvious to try" rationale does not provide a sufficient basis for a conclusion of

obviousness. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). Accordingly, because there is no suggestion or motivation to combine Camrud '117 and Kocur, amended claim 27 is allowable. The prior art of record also fails to disclose the additional limitations of dependent claims 28-47. Because each of these claim incorporate all of the limitations of allowable claim 27, claims 28-47 are also allowable. Therefore, any further arguments that could be made at this time in support of the additional limitations of Applicants' dependent claims would be superfluous and unnecessary. *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555 (Fed. Cir. 1983).

Turning to claims 48-49, Applicants have incorporated the limitation of claim 21 into independent claim 48. The Examiner has argued that Camrud '117 discloses all of the limitations of claim 21, which requires the connector member to be curved (now incorporated into claim 48). However, Applicants respectfully submit that Camrud '117 does not disclose this limitation. With respect to claim 21, the Examiner has stated that interlocking link 108 disclosed in Camrud '117 is curved. (Figure 7A, 7B, col. 10, lines 7-19). However, it is clear from the disclosure of Camrud '117 and the related figures that interlocking link 108 is not biodegradable. In Figures 7A and 7B, the only biodegradable component is material 113, which is filled into the overlap regions 110, 112 between the stent sections and the interlocking link 108. By contrast, in claim 48 the connector member is curved and biodegradable. Camrud '117 does not disclose a connector member that is both curved and biodegradable. Accordingly, Camrud '117 does not disclose all of the limitations of claim 48. Therefore, claim 48 is allowable. In addition to these missing limitations, the prior art of record fails to disclose the additional limitation of dependent claim 49. Because this claim incorporates all of the limitations of allowable claim 48, claim 49 is also allowable. Therefore, any further arguments that could be made at this time in support of the additional limitation of Applicants' dependent claim would be superfluous and unnecessary. *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555 (Fed. Cir. 1983).

Turning to claim 50, Applicants have distinguished claim 50 from the prior art by reciting, inter alia, that the "connector member [is] elongate and extend[s] across a

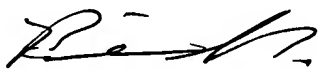
space separating adjacent ring structures, said connector member comprising a first end joined to one ring structure and a second end joined to an adjacent ring structure.” Applicants respectfully submit that Camrud ’117 does not disclose this limitation. Referring to Figures 3 and 4 of Applicants’ application as an example, biodegradable connector member 118 extends across the space between ring structures 114. (¶ [0037]). The biodegradable connector member 118 has a first end 132 connected to one ring structure 114 and a second end 136 connected to an adjacent ring structure 114. (¶ [0038]). The space between the ring structures is also shown as distance c in Figure 9. (¶ [0048]). As shown in Figure 4, when the biodegradable connector member 118 degrades, the ring structures 114 become disjointed from each other and the space between the ring structures 114 keeps the ring structures 114 separated from each other. None of the structures disclosed in Camrud ’117 disclose a biodegradable connector member that extends across a space between two adjacent ring structures. Indeed, Camrud ’117 teaches away from the claimed structure. For example in Figures 4A-4C and 5A-5B, Camrud ’117 discloses stent sections with non-biodegradable rod-like or tab-like connecting members 70, 72, 74, 76, 80, 82, 84, 86 that extend between the stent sections. (Col. 8, line 9 to col. 9, line 22). In Figures 4A-4B, the connecting members 70, 72, 74, 76 include a weakened portion 78 that promotes breakage. (Col. 8, lines 22-32). In Figures 4C and 5A-5B, the connecting members 80, 82, 84, 86 form two halves that can be held together with a biodegradable material 90. (Col. 8, lines 54-57). In describing the advantage of the rod-like and tab-like connecting members, Camrud ’117 states: “Use of rod-like elements as connecting members 70, 72, 74, 76 can provide the added benefit of stability to stent sections 12, 14, 16, 18. In particular, the rod-like elements extend outward from stent sections 12, 14, 16, 18 and can engage the inner wall of the body lumen to resist axial tumbling of the respective stent section. For added stability, connecting members 70, 72, 74, 76 may take the form of tab-like elements that, relative to rod-like elements, exhibit greater lateral surface area for contact with the lumen wall. In either case, the resulting connecting members 70, 72, 74, 76 provide extensions that counteract tumbling forces.” Thus, Camrud ’117 teaches that it is desirable to have a non-biodegradable connecting member extend partially across the space between the stent sections to provide added stability. By contrast, in

the claimed invention of claim 50, the biodegradable connector member extends all the way across the space between adjacent ring structures. Accordingly, Camrud '117 does not disclose all of the limitations of claim 50. Therefore, claim 50 is allowable.

## **Conclusion**

In response to the Examiner's comments, Applicants have amended claim 27 and added new claims 48-50. Applicants have also cancelled claim 30. It is respectfully submitted that none of the prior art of record discloses all of the limitations of the claims as now presented. Furthermore, there is no suggestion or motivation to combine the prior art to achieve Applicants' claimed inventions. Therefore, Applicants' claims are allowable. Accordingly, Applicants request reconsideration and allowance of the application.

Respectfully submitted,



---

Richard E. Stanley, Jr.  
Registration No. 45,662  
Attorney for Applicants

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200